

Application No. 10/750,570
Response to Restriction Requirement

Docket No.: 60188CON2 (49947)

REMARKS

Claims 1-17 are pending in the instant application and are subject to restriction. The Office Action, on page 2, requires restriction to one of the following groups under 35 U.S.C. §121:

- I. Claim 1, drawn to compounds of formula I.
- II. Claims 2-3 and 15-16, drawn to compounds of formula II.
- III. Claims 4-14, drawn to methods of using comopunds of formulae I and II for treating various disorders.
- IV. Claim 17, drawn to a package of compounds of formula II.

Applicants are required to elect one of the above groups for prosecution on the merits. Applicants respectfully traverse the requirements for restriction and election, and submit that the requirements are improper.

Applicants assert that the subject matter of these groups represent different embodiments of a single inventive concept for which a single patent should issue. The pending claims represent an intricate web of knowledge, continuity of effort, and consequences of a single invention, which merit examination in a single application.

The unifying concept of the claimed embodiments of the invention is vitamin D₃ compounds for the treatment of disorders, compositions and packaged compounds. This compounds of formula I and formula II is the core concept of the claims in Groups I-IV.

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Notwithstanding the foregoing, Applicants submit that a sufficient search and examination with respect to the subject matter of all claims can be made without serious burden. As the M.P.E.P. states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (8th ed., Rev. No. 6).

That is, even if the above-enumerated groups of claims are drawn to distinct inventions, the Examiner must still examine the entire application on the merits because doing so will not result in a serious burden.

Applicants submit that the search and examination of all the claims will have substantial overlap, and no serious burden will result from searching and examining all claims in the same application. This is especially true given the extensive computer databases and powerful search engines at the Examiner's disposal.

Accordingly, in the interest of savings of time and cost to Applicants and the Patent Office, Applicants respectfully request that all the claims be searched and examined in a single application and that all groups be rejoined into a single group.

Nevertheless, in compliance with the directives in the Office Communication and in order to expedite prosecution of the instant application, Applicants hereby provisionally elect, subject to the foregoing traverse, Group II, claims 2-3 and 15-16, drawn to compounds of formula II.

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Additionally, the Office Action indicates that a single species election is required for search purposes. Applicants traverse but hereby elect 1 α , 24-dihydroxy 24-methyl 3-epi vitamin D₃, which is disclosed in claim 3.

If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned attorney at (617) 239-0100.

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Respectfully submitted,

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